

## REMARKS

Upon entry of this Amendment, claims 1 - 11 and 13-31 are pending in this application. Claim 12 was previously canceled. Applicant has amended claims 1, 9, 18, and 26.

### CLAIM REJECTIONS – 35 U.S.C. §102(b)

Claims 1, 8, 26, 27 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,499,638 (“Campbell”).

#### Independent Claim 1

Amended claim 1 defines, among other things, a saddlebag mounting system including a saddlebag and a saddlebag frame. The saddlebag includes a lower end, an upper end opposite the lower end and defining an upward direction, and a cover located at the upper end. The saddlebag defines a cavity, the cover being movable to expose and provide access to the cavity from the upper end of the saddlebag. The saddlebag frame includes a hook member configured to hang from a portion of the motorcycle to at least partially support the saddlebag. The saddlebag frame further includes a first attachment member and a second attachment member spaced a distance from the first attachment member. The first and second attachment members are configured to couple the saddlebag frame to the portion of the motorcycle. The hook member is in a position above positions of the first and second attachment members and located between the first and second attachment members.

Campbell discloses a bag 1 that is detachable from a mounting plate 2 (Fig. 1). The bag 1 includes female coupling members 6 that receive male coupling members 8 of the mounting plate 2. The mounting plate includes a J-shaped lip 7 that receives the seam 5 of the bag 1.

Campbell does not teach, among other things, a hook member in a position above the position of first and second attachment members relative to an upward direction defined by the upper end, the lower end, and the cover of the saddlebag. Rather, Campbell discloses a vaguely hook-shaped seam 5 of the bag 1 beneath the female coupling members 6.

The Examiner contends that the device of Campbell may be viewed from a different orientation (e.g., upside-down), and when viewed in such an orientation, Campbell anticipates Applicants' claim. In order to support such an interpretation, the Examiner points to the base portion of the bag 1 of Campbell as the "cover". Clearly Campbell does not suggest that this portion of the bag 1 is a cover. Applicants have further amended claim 1 to define the cover, distinguishing that the cover is movable to expose and provide access to the cavity defined by the saddlebag from the upper end of the saddlebag. While the Examiner has initially interpreted the limitation of the "cover" to be essentially any item that covers anything, amended claim 1 now recites the particular structure of the cover, which prevents the device of Campbell from being considered in an upside-down orientation, as the bag 1 lacks any cover as defined by Applicants' claim 1 in such an orientation.

Furthermore, amended claim 1 defines the hook member configured to hang from a portion of the motorcycle to at least partially support the saddlebag. The seam 5 of Campbell is structurally incapable of hanging from anything in the Examiner's modified viewpoint. The seam 5 of Campbell rests down into the lip 7 in Campbell's normal orientation. When flipped upside-down, the lip 7 opens downwardly, and therefore, the seam 5, which is shaped to fit inside the lip 7, cannot possibly hang from the lip 7 (or any other part of the mounting plate 2) to support the bag 1.

For at least these reasons, Campbell does not teach or suggests all of the subject matter of amended claim 1, and therefore amended claim 1 is allowable. Claims 2-8 depend from allowable claim 1 and are allowable for the same and other reasons.

#### Independent Claim 26

Amended claim 26 defines, among other things, a saddlebag assembly that includes a saddlebag, a hook coupled to the saddlebag and configured to hang from the motorcycle, a first attachment member, and a second attachment member. The saddlebag includes a lower end, an upper end opposite the lower end and defining an upward direction, and a cover located at the upper end. The saddlebag defines a cavity, the cover being movable to expose and provide access to the cavity from the upper end of the saddlebag. The first and second attachment members substantially inhibit movement of the saddlebag in the upward direction

when the saddlebag is coupled to the motorcycle and the hook is in a position above positions of the first and second attachment members and located between the first and second attachment members.

Campbell does not teach or suggest, among other things, a saddlebag frame including a hook in a position above positions of first and second attachment members relative to an upward direction defined by the upper end, the lower end, and the cover of the saddlebag. Rather, Campbell discloses the seam 5 of the bag 1 beneath the female coupling members 6 (see Fig. 1 of Campbell).

As with claim 1, the Examiner contends that the device of Campbell, re-oriented in an upside-down configuration, anticipates claim 26. Similar to claim 1, discussed above, claim 26 is amended to more clearly define the structure of the cover. Thus, the immovable base portion of Campbell's bag 1 cannot be interpreted as a cover, as it is not located at an upper end of the saddlebag and movable to expose and provide access to a cavity from the upper end of the saddlebag.

Furthermore, amended claim 26 defines the hook member configured to hang from the motorcycle to at least partially support the saddlebag. The seam 5 of Campbell is structurally incapable of hanging from anything in the Examiner's modified viewpoint. The seam 5 of Campbell rests down into the lip 7 in Campbell's normal orientation. When flipped upside-down, the lip 7 opens downwardly, and therefore, the seam 5, which is shaped to fit inside the lip 7, cannot possibly hang from the lip 7 (or any other part of the mounting plate 2) to support the bag 1.

For at least these reasons, Campbell does not teach or suggests all of the subject matter of amended claim 26, and therefore amended claim 26 is allowable. Claims 27-31 depend from allowable claim 26 and are allowable for the same and other reasons.

#### CLAIM REJECTIONS – 35 U.S.C. §103(a)

The Examiner has reject claims 2-5, 7, 9-11, 13, 14, 16-22, 24, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Campbell in view of United States Patent Application Publication No. 2003/0122002 ("Monson").

### Independent Claim 9

Amended claim 9 defines, among other things, a saddlebag mounting system that includes a saddlebag mount fixedly attached to a fender support of a motorcycle. The saddlebag mount includes a bar attached to and extending along the fender support. The bar defines a first side facing the saddlebag frame when the saddlebag frame is engaged with the saddlebag mount and a second side opposite the first side including a cavity having an opening that faces away from the saddlebag and configured to face toward the fender support when the saddlebag frame is engaged with the saddlebag mount. The bar includes a first attachment member disposed within the cavity and adapted to couple to a saddlebag.

Campbell discloses a mounting plate 2 having a J-shaped lip 7 at a bottom edge thereof. The lip 7 forms an upwardly-opening pocket into which the seam 5 at the bag's lower edge is received to mount the bag 1. Campbell fails to teach or suggest the mounting plate 2 fixedly attached to a fender support of the motorcycle.

Monson discloses a saddlebag 40 and a saddlebag frame 44 (Fig. 2A). A mounting structure 64 including bolts 56 and pins 68 mounts the frame 44 and saddlebag 40 to the fender strut 14 (Fig. 5).

Campbell and Monson, alone or in combination, fail to teach or suggest, a saddlebag mount fixedly attached to a fender support and including a bar that defines a first side facing the saddlebag frame when the saddlebag frame is engaged with the saddlebag mount and a second side opposite the first side including a cavity having an opening that faces away from the saddlebag and configured to face toward the fender support when the saddlebag frame is engaged with the saddlebag mount, the bar including a first attachment member disposed within the cavity and adapted to couple to the saddlebag.

Rather, Campbell discloses the mounting plate 2 having mounting holes 10 (Fig. 2). The mounting holes 10 are used to secure the plate 2 to a planar surface or via transitional links to the frame of a motorcycle (column 4, lines 3-8). Male coupling members 8 extend outwardly from the plate 2 and are received by female coupling members 6 of the saddlebag panel 3 to secure the bag 1 to the mounting plate 2. Examiner's Figure 2 in the June 5, 2007

Office action points to a “cavity” formed by the lip 7. The Examiner states that the opening of the cavity can face in any number of directions, including away from the saddlebag and toward the fender support. While this represents quite an exaggeration to construe Campbell according to Applicants’ claim, Applicants appreciate the Examiner’s responsibility to interpret the claim language broadly.

Applicants have amended claim 9 to more clearly define the structure of the bar, which includes first and second opposite sides, the first side facing the saddlebag frame when the saddlebag frame is engaged with the saddlebag mount and the second side (opposite the first side) including a cavity having an opening that faces away from the saddlebag and configured to face toward the fender support when the saddlebag frame is engaged with the saddlebag mount. The mounting plate 2 of Campbell generally includes two side faces, one of the side faces being curled to form the lip 7. The side face with the lip 7 is oriented generally toward the bag 1 so that the seam 5 of the bag 1 may be received into the lip 7 when mounted. Even when considering the Examiner’s Figure 2 and the directional arrow indicating a supposed direction of the opening “away from the saddlebag”, the cavity opening of Campbell is not defined on a side of the mounting plate 2 opposite a side that faces the bag 1. Such a modified mounting plate 2 is not operable to receive the seam 5 of the bag 1 within the lip 7. Accordingly, because the modified mounting plate 2 is rendered completely useless for its intended purpose, there is no motivation to modify Campbell to provide the lip 7 on the opposite side. Thus, amended claim 9 distinguishes over Campbell, which cannot simply be re-oriented to meet the limitations of Applicants’ claim.

Monson discloses attaching the frame 44 to the fender strut 14 using bolts 56 that are located in holes 76 of the plate 72. However, Monson fails to cure the deficiencies of Campbell detailed above.

Accordingly, neither Campbell nor Monson, alone or in combination, teach or suggest all of the subject matter of amended claim 9, and therefore claim 9 is allowable. Claims 10, 11, and 13-17 depend from allowable claim 9 and are allowable for the same and other reasons.

### Independent Claim 18

Amended claim 18 defines, among other things, a saddlebag and a saddlebag mount that includes a bar that extends along a portion of the length of a motorcycle. The bar defines a first side facing the saddlebag frame when the saddlebag frame is engaged with the bar and a second side opposite the first side including a cavity having an opening that faces away from the saddlebag and configured to face toward the motorcycle when the saddlebag frame is engaged with the bar. The bar includes a first attachment member disposed within the cavity and adapted to couple to the saddlebag.

For the same reasons as detailed above with respect to claim 9, Campbell cannot be construed to include a bar having first and second opposing sides, the second side (opposite a side facing the saddlebag frame when the saddlebag frame is engaged with the bar) including a cavity having an opening that faces away from the saddlebag and configured to face toward the motorcycle when the saddlebag frame is engaged with the bar. The lip 7 is on a first side of the mounting plate 2, which is oriented generally toward the bag 1. The device of Campbell cannot be modified to reverse the orientation of the lip 7 as it would render the device useless for its intended purpose of receiving the seam 5 of the bag 1.

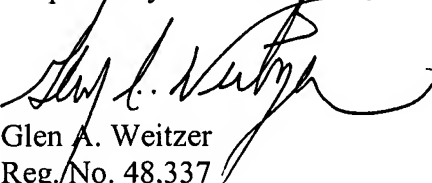
Monson discloses attaching the frame 44 to the fender strut 14 using bolts 56 that are located in holes 76 of the plate 72. However, Monson fails to cure the deficiencies of Campbell detailed above.

Accordingly, neither Campbell nor Monson, alone or in combination, teach or suggest all of the subject matter of amended claim 18, and therefore, amended claim 18 is allowable. Claims 19-25 depend from allowable claim 18 and are allowable for the same and other reasons.

Applicant believes that this Amendment places the application in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner enter the foregoing amendments, and allowance of the claims 1-11 and 12-31 is respectfully requested.

The Examiner is invited to contact the undersigned attorney should the Examiner determine that such action would facilitate the prosecution and allowance of the present application.

Respectfully submitted,



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